

REMARKS

Claims 1-38 were originally presented for review. Claims 20 and 24 are amended herein to correct typographical errors. Entry and consideration of these amendments are respectfully requested.

The Office action asserts that claims 1-38 are directed to two patentably distinct inventions, namely:

Group I: Which includes claims 1-23 allegedly drawn to a dumping station with indicator having a programmable control classified in Class 700, Subclass 216; and

Group II: Which includes claims 24-38 allegedly drawn to a dumping station with indicator classified in Class 414, Subclass 289.

The Office action asserts that Groups I and II are related as combination and subcombination, respectively. Referring to M.P.E.P. § 806.05(c), the office action states that the inventions are distinct "if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations." With regard to the first element, the Office action argues that the combination specified in the Group I claims "...does not require the particulars of the subcombination as claimed because the dumping station may be used in a manual or non-automated version or with a version using controls not requiring a computer." As for the second element, the Office action states that "The subcombination has separate utility such as to be used as a receptacle which is manually charged based on a manual indicator."

For the reasons presented below, Applicant traverses the restriction requirement and proposes an alternative restriction between Proposed Group I, consisting of claims 1-26, and Proposed Group II, consisting of claims 27-38. Reconsideration is respectfully requested.

I. THE EFFECTS OF THE PATENT OFFICE'S POSITION ARE VARIOUS ADMISSIONS CONCERNING PATENTABILITY

The effect of the position in the official action is that the Patent Office admits that the Group I claims are patentable over a disclosure of the subject matter of the Group II, and *vice*

versa. M.P.E.P. § 802.01 states that **the distinctness required for restriction means that the subjects, including "combination and part (subcombination) thereof ... ARE PATENTABLE (novel and unobvious) OVER EACH OTHER"** (emphasis with capital letters in original). (See also M.P.E.P. § 808.02, which states that where "related inventions are not patentably distinct as claimed, restriction ... is never proper.")

Thus, the effect of this restriction requirement, unless withdrawn, is that the Patent Office admits that the dumping station of the Group II claims is patentable over any disclosure of a dumping station according to the Group I claims. *See, e.g.*, M.P.E.P. § 802.01. Likewise, the effect of this restriction requirement, unless withdrawn, is that the Patent Office admits that the claimed dumping station of the Group I claims is patentable over any disclosure of a dumping station according to the Group II claims. *Id.* Claims 1-23 of the Group I claims and claims 24-26 of the Group II claims include similar elements, and therefore such admissions would appear to be improper.

In addition, where restriction is required, a double patenting rejection may not later be made, and therefore "it is imperative the requirement should never be made where related inventions as claimed are not distinct." M.P.E.P. § 806.

These positions are necessary to entry of the election requirement by the Patent Office and may be relied upon by the applicants during examination of this and continuing applications, unless the restriction requirement is withdrawn. If the Examiner is not taking these positions, then it is submitted that the election requirement should be withdrawn upon reconsideration.

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II. THE STANDARD FOR REQUIRING RESTRICTION HAS NOT BEEN MET BECAUSE THE CRITERIA OF DISTINCTIVENESS HAVE NOT BEEN DEMONSTRATED

The restriction requirement is improper because the criteria of distinctiveness in M.P.E.P. § 806.05(c) have not been demonstrated. To show distinctiveness, M.P.E.P. § 806.05(c) requires in part that “(1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations.” Applying these requirements to the present claims, the restriction between the claims of Groups I and II is improper.

Each of independent claims 1 and 24 specifies similar dump station subject matter. Independent claim 1, classified in Group I, recites a bin having a receiving end adapted to receive articles and a discharge end, the bin having a dump and pick modes, a releasable latch positioned to retain the bin against the force of gravity responsive to a release signal, and a controller having a processor programmed to generate the release signal. Independent claim II, classified in Group II, similarly recites a method of operating a dump station having a bin with receiving end adapted to receive articles and a discharge end, the bin having dump and pick modes, and the steps of latching the pin in the pick mode and releasing the latch in response to a release signal.

Accordingly, the primary difference between these groups of claims is that claims 1-23 of Group I recite a controller having a processor programmed to generate release signals for the latch, whereas claims 24-26 of Group II do not recite the controller or processor. Applicant notes, however, that claims 24-26 do not exclude the use of a controller and processor to generate release signals for the latch. In any event, whether or not a controller and/or processor are present does not sufficient distinguish the claims that they are patentable

over each other, and therefore the distinctiveness required for restriction does not exist, at least with respect to claims 1-23 and 24-26.

Furthermore, the reasons provided in the office action for the distinctiveness of the Groups do not support a conclusion that the criteria of distinctiveness are met. The office action asserts that the combination as claimed does not require the particulars of the subcombination as claimed because "the dumping station may be used in a manual or non-automated version or with a version using controls not requiring a computer." This statement, however, fails to identify one particular of the subcombination that is not required in the combination. Instead, it merely identifies the utility of the subcombination in other combinations, and therefore supports, if anything, the second element of distinctiveness. Accordingly, the restriction requirement as stated is incomplete, and should be withdrawn.

As a further point, applicants note that the descriptions of Groups I and II as stated in the Office action mischaracterize the subject matter of the claims. In the Office action, the claims of Groups I and II are both said to be drawn to a dumping station "with indicator." Independent claims 1 and 15 of Group I and independent claim 24 of Group II do not recite an "indicator." Of the Group I claims, only dependent claim 5 introduces an "indicator". None of claims 24-26 in Group II recite an indicator. Accordingly, the description of the subject matter of Groups I and II is incorrect.

The rationale articulated with respect to the second element of distinctiveness fails to accurately reflect the subject matter of the claims. More specifically, the stated rationale is that the subcombination has separate utility as a receptacle "that is manually charged based on a manual indicator." As noted above, however, independent claims 1 and 15 of Group I and independent claim 24 of Group II do not specify an indicator. Accordingly, this

statement does not accurately reflect the subject matter of the claims and therefore the Office action fails to identify proper rationale for meeting the second element of distinctiveness.

For the foregoing reasons, the applicant traverses the restriction requirement on the grounds that the criteria of distinctiveness between Groups I and II have not been demonstrated.

III. THE STANDARD FOR REQUIRING RESTRICTION HAS ALSO NOT BEEN MET BECAUSE SEARCH AND EXAMINATION OF THE ENTIRE APPLICATION CAN BE MADE WITHOUT SERIOUS BURDEN ON THE EXAMINER

The restriction requirement is improper on its face because it does not meet the requirement that search and examination of the entire application must be a serious burden on the examiner. M.P.E.P. § 803 states:

“If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

The applicant thus further traverses the restriction requirement on the ground that there is no evidence, or even allegation, that search and examination of the entire application would be a *serious burden* on the examiner, as required. Instead, the office action simply notes that the claims of Group I would be classified in class 700, subclass 216, while the Group II claims would be classified in class 414, subclass 289.

To the contrary, and in light of the common subject matter specified in the claims (as noted above), a complete search directed to the subject matter of the claims of Group I would require a search directed to the subject matter of the claims of Group II, and vice versa. The subject matter of these claims is not distinct and therefore search and examination of the entire application would not result in serious burden on the Examiner.

As such, it would be wasteful of the time, effort, and resources of both the applicant and the Patent Office to prosecute these claims in separate applications. Search and examination of the two groups of claims together would be much more efficient than requiring the Patent Office and the applicant to do so separately in multiple applications.

IV. PROVISIONAL ELECTION WITH REGARD TO THE RESTRICTION REQUIREMENT

To satisfy 37 C.F.R. 1.143, the applicant hereby provisionally elects for examination on the merits, with traverse, the claims of Group I, i.e., claims 1-23. In doing so, the applicant does not intend to abandon the scope of the non-elected claims as originally filed, but may pursue the non-elected claims, either by petition for further review or in a divisional application, if the restriction requirement is not withdrawn upon reconsideration.

V. PROPOSED ALTERNATIVE CLAIM GROUPS

Rather than restricting between claims 1-23 and claims 24-38, Applicant submits that the claims are better grouped in Proposed Group I consisting of claims 1-26 and Proposed Group II consisting of claims 27-38. If restricted in this manner, the claims of Proposed Group I would all be directed to a dumping station and method having at least a bin and releasable latch, while the claims of Proposed Group II would all be directed to a dumping station and method having at least a bin and a status indicator. Should the Examiner adopt these alternative claim groups, Applicants elect the claims of Proposed Group I, which includes claims 1-26.

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Amdt. dated Nov. 7, 2003
Reply to Office action of Oct. 3, 2003

It is submitted that the present application is in good and proper form for allowance.

A favorable action on the part of the Examiner is respectfully solicited.

If, in the opinion of the Examiner a telephone conference would expedite prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,
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